

**REMARKS**

This communication is a full and timely response to the non-final Office Action dated September 30, 2004 (Paper No./Mail Date 20040624), the period of response being extended through a Petition for Three-Month Extension of Time submitted herewith. By this communication, claims 1, 5, and 10 are canceled without prejudice or disclaimer of the underlying subject matter. Claims 2, 3, 6, and 8 have been amended, and claim 14 has been added.

Claim 2 has been amended to depend from claim 8 and to recite an input unit that inputs an identifier assigned to the contact lens, wherein the calculation unit retrieves the correction pattern data from the storage unit with reference to the inputted identifier. Support for the changes to claim 2 can be found variously throughout the specification, for example, at paragraphs [0030] and [0058] of the corresponding published application (U.S. Patent Application Publication No. 2002-0040219). No new matter has been added.

Claim 3 has been amended to depend from claim 8 and to recite a revising unit that revises the retrieved correction pattern data or data on the determined correction pattern, wherein the calculation unit obtains the ablation control data based on the revised data. Support for the changes to claim 3 can be found variously throughout the specification, for example, at paragraphs [0030] and [0058] of the corresponding published application (2002-0040219). No new matter has been added.

Claim 6 has been amended to improve form. No new matter has been added.

Claim 8 has been amended to recite an ablation unit that comprises a laser light source emitting a laser beam and an irradiation optical system for irradiating the emitted laser beam onto a cornea of the patient's eye; a storage unit that stores data on correction patterns on a plurality of kinds of contact lenses, each correction pattern having a different far vision and near vision zone pattern; and a calculation unit that retrieves correction pattern data on a contact lens for a trial use corresponding to data on prescription provided to the patient's eye from the storage unit, determines a correction pattern for the patient's eye based on the retrieved correction pattern data, and obtains ablation. Support for the changes to claim 8 can be found variously throughout the specification, for example, at paragraphs [0055] and [0058] of the corresponding published application (2002-0040219). No new matter has been added.

Claim 14 has been added. Claim 14 depends from claim 6 and additionally recites a process in which the determined correction pattern for the patient's eye or the correction pattern of the contact lens which bears a good result is revised. Support for the subject matter recited in claim 14 can be found variously throughout the specification, for example, at paragraph [0007] of the corresponding published application (2002-0040219). No new matter has been added.

Claims 2, 3, 6-9, and 14 are pending where claims 6 and 8 are independent.

### **Rejections Under 35 U.S.C. §103**

Claims 1-3 and 5-10 were rejected under 35 U.S.C. §103(a) as unpatentable over *Amano et al.*, U.S. Patent No. 6,190,374 in view of *Lieberman et al.*, U.S. Patent No. 6,416,179. Applicant respectfully traverses this rejection.

As discussed above, claims 1, 5, and 10 were canceled without prejudice. Thus, the rejection concerning these claims is moot and should be withdrawn. The rejection of remaining claims 2, 3, and 6-9 are addressed below.

Claim 6 recites a correction data determining method of correcting a refractive error by ablating corneal tissue of a patient's eye with a laser beam comprising a process in which an ophthalmic examination of the patient's eye including a refractive power inspection is performed, and data on prescription provided to the patient's eye is obtained; a process in which a first contact lens for providing the patient's eye with refractive power of a first correction pattern having a first far vision and near vision zone pattern, which corresponds to the obtained data on prescription is prepared; a process in which the first contact lens is put on the patient's eye for a trial use and a result of the trial use is checked to determine whether the result is good or bad; and a process in which, if the trial use of the first contact lens bears a good result, a correction pattern for the patient's eye is determined based on the first correction pattern, and if the trial use of the first contact lens bears a bad result, a second contact lens for providing the patient's eye with refractive power of a second correction pattern having a second far vision and near vision zone pattern, which is different from the first correction pattern, is put on the patient's eye for a trial use, and the correction pattern for the patient's eye is determined based on a correction pattern of a contact lens which bears a good result.

Claim 8 recites a corneal surgery apparatus for correcting a refractive error by ablating corneal tissue of the patient's eye with a laser beam comprising an ablation unit that comprises a laser light source emitting a laser beam and an irradiation optical system for irradiating the

emitted laser beam onto a cornea of the patient's eye; a storage unit that stores data on correction patterns on a plurality of kinds of contact lenses, each correction pattern having a different far vision and near vision zone pattern; and a calculation unit that retrieves correction pattern data on a contact lens for a trial use corresponding to data on prescription provided to the patient's eye from the storage unit, determines a correction pattern for the patient's eye based on the retrieved correction pattern data, and obtains ablation control data based on the determined correction pattern.

In summary, according to the present invention, a contact lens for refractive correction has a posterior shape (curve) that is formed to fit the corneal shape (curve) of a wearer's eye (an eye to be operated on) and an anterior shape (curve) that is formed to assign desired refractive corrective power to the wearer's eye.

*Amano* discloses an apparatus for operating upon a cornea for correcting not only hypermetropia or myopia but also presbyopia. However, *Amano* only teaches a correction optical system for correcting myopia, hypermetropia and presbyopia, and a method of ablation by controlling the correction optical system. The Office Action acknowledges that *Amano* fails to disclose, teach, or suggest at least that corneal correction is determined by fitting the patient's eye with a contact lens, and relies on *Lieberman* to remedy this deficiency.

The Office Action alleges that *Lieberman* teaches a method for performing corneal ablation in which a contact lens is used to determine the desired vision correction. However, the disclosure of *Lieberman* fails to support the allegations of the Office action. In particular, the contact lens disclosed by *Lieberman* is used to prepare a moldable mask in which a shape of its surface (an anterior surface) is formed into a corneal shape after ablation (this corneal shape is determined based on a shape of a preoperative cornea and its refractive error). Thus, *Lieberman* fails to disclose, teach, or suggest using a contact lens to determine the desired vision correction.

Moreover, the contact lens disclosed by *Lieberman* does not correspond to a contact lens for refractive correction, as recited in claims 6 and 8. Further, in preparing the contact lens for refractive correction, it is necessary to form the respective shapes of the anterior and posterior surfaces as mentioned above. *Lieberman* fails to suggest that a surgeon has used a contact lens as recited in claims 6 and 8 for obtaining reliable data.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, obviousness "cannot be established by combining the teachings of the prior

art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. V. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). For at least the reasons discussed above, Applicant respectfully requests that the rejection of claims 6 and 8 under 35 U.S.C. §103 be withdrawn and these claims be allowed.

Claim 7 depends from claim 6, and claims 2, 3, and 9 depends from claim 8. By virtue of this dependency, Applicants submit that claims 2, 3, 7, and 9 are allowable for at least the same reasons given above with respect to their respective base claims. In addition, Applicants submit that claims 2, 3, 7, and 9 are further distinguished over *Amato* and *Lieberman* by the additional elements recited therein, and particularly with respect to each claimed combination. Applicants respectfully request, therefore, that the rejection of claims 2, 3, 7, and 9 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

**Newly Added Claim**

Claim 14 depends from claim 6 and additionally recites a process in which the determined correction pattern for the patient's eye or the correction pattern of the contact lens that bears a good result is revised. By virtue of this dependency, Applicant submits that claim 14 is allowable for at least the same reasons given above with respect to claim 6. In addition, Applicant submits that claim 14 is further distinguished over *Amato* and *Lieberman* by the additional elements recited therein, and particularly with respect to the claimed combination. Accordingly, Applicant respectfully requests that the claim 14 be considered and allowed.

**Conclusion**

Based on at least the foregoing amendments and remarks, Applicants submit that claims 2, 3, 6-9, and 14 are allowable, and this application is in condition for allowance. Accordingly, Applicants request favorable reexamination and reconsideration of the application. In the event the Examiner has any comments or suggestions for placing the application in even better form, Applicants request that the Examiner contact the undersigned attorney at the number listed below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. WEN-008 from which the undersigned is authorized to draw.

Dated: December 27, 2004

Respectfully submitted,

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